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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Masayuki KANEHIRA

Art Unit: 382

Application No.: 10/799,753

Examiner: L. A. Footland

Filed: March 15, 2004

Washington, D.C.

For: BIAxIAL LINEAR-REVOLVING POSITION CONTROL AND...

Atty.'s Docket: KANEHIRA=1

Confirmation No.: 9119

Date: November 21, 2006

Customer Service Window, **Mail Stop Amendment**
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314

Sir:

Transmitted herewith is a **REPLY TO REQUIREMENT FOR ELECTION OF SPECIES** in the above-identified application.

- ☐ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.
☒ No additional fee is required.
☐ The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	** 20	0	x 25	\$		x 50	\$
INDEP.	*	MINUS	*** 3	0	x 100	\$		x 200	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 180	\$		+ 360	\$
					ADDITIONAL FEE TOTAL	\$		TOTAL	\$

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity		Other Than Small Entity	
Response Filed Within		Response Filed Within	
<input type="checkbox"/> First	- \$ 60.00	<input type="checkbox"/> First	- \$ 120.00
<input type="checkbox"/> Second	- \$ 225.00	<input type="checkbox"/> Second	- \$ 450.00
<input type="checkbox"/> Third	- \$ 510.00	<input type="checkbox"/> Third	- \$ 1020.00
<input type="checkbox"/> Fourth	- \$ 795.00	<input type="checkbox"/> Fourth	- \$ 1590.00
Month After Time Period Set		Month After Time Period Set	

☐ Less fees (\$) already paid for ___ month(s) extension of time on _____.

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$ _____.

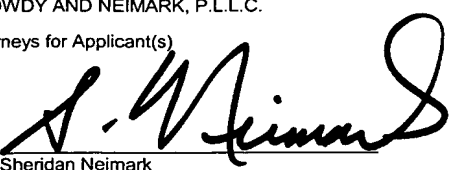
☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ _____.

☐ A check in the amount of \$ _____ is attached (check no.).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By: 
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Confirmation No.: 9119
)	
Masayuki KANEHIRA)	Art Unit: 3682
)	
Appln. No.: 10/799,753)	Examiner: L. A. Footland
)	
Filing Date: March 15, 2004)	November 21, 2006
)	
For: BIAXIAL LINEAR-REVOLVING)	ATTY.'S DOCKET: KANEHIRA=1
POSITION CONTROL AND...)	

REPLY TO REQUIREMENT FOR ELECTION OF SPECIES

Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314

Sir:

The applicant is in receipt of the Office Action mailed October 23, 2006, entirely in the nature of a requirement for election of species. Applicant replies below.

First, however, applicant respectfully requests the PTO to acknowledge receipt of applicant's papers filed under Section 119.

An election of species has been required among what the PTO deems to be six (6) patentably distinct species. As applicant must make an election even though the requirement is traversed, applicant hereby respectfully and provisionally elects the species of Figs. 10-15 with traverse and without prejudice. The claims which read on this species, including generic claims, are claims 1-3, 9-12 and 14-21.

Appln. No. 10/799,753
Amd. dated November 21, 2006
Reply to Office Action of: October 23, 2006

Applicant does not deny that the species may indeed be patentably distinct from one another, i.e. define non-obvious subject matter over one another. Accordingly applicant's traversal is based on the second paragraph of MPEP 803, which **requires** a search and examination of patentably distinct inventions, **even when the requirement is correct**, if it would not constitute a "serious burden" to do so. Applicant submits that at least some of the species are not so different from the elected species that it would constitute a serious burden to also examine these non-elected species.

Applicant further notes that no separate classification has been demonstrated. Accordingly, it would appear that a **complete** search of the elected species would also require a search of at least some of the non-elected species. Once such a search has been conducted, the burden of examining those additional species would be only a minimal, i.e. not a serious burden.

Accordingly, applicant requests at least a partial withdrawal of the election of species requirement and an examination on the merits of additional species along with the elected species.

Respectfully submitted,

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